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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,709	02/23/2004	Paul Weatherbee	MAE-WW-2	1478
7590 Michael A. Ervin 8202 Talbot Cove Austin, TX 78746			EXAMINER TRIEU, THERESA	
			ART UNIT 3748	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	01/18/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/784,709	Applicant(s) WEATHERBEE, PAUL	
	Examiner Theresa Trieu	Art Unit 3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 18-20, 22, 23, 28, 29, 32, 48-50, 53 and 54 is/are pending in the application.
4a) Of the above claim(s) 55 and 56 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 18-20, 22, 23, 28, 29, 32, 48-50, 53 and 54 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is responsive to the applicants' amendment filed on Oct. 30, 2006.

Claims 1 and 32 have been amended. Claims 3-17, 21, 24-27, 30, 31, 33-47 and 51-53 have been canceled. Claims 55 and 56 have been added.

Oath/Declaration

1. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. The claims 1 and 32 are broader than the original claims 1 and 32 since the applicant had removed the elements of "wherein at least a portion of said first shaft extends through the housing wall; a first fluid and a second fluid flow through the fluid machine; a first fluid and a second fluid and connecting said first and second fluids to appropriate port openings to enable separate movement of said first and second fluids through said fluid machine" (see pages 2, 7 and 8). A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Election/Restrictions

2. Newly submitted claims 55 and 56 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 55 and 56 have been claimed to the carrier ring being an exterior ring mounted in the wall of the housing and these claims appear to read on the species of in Figure 15.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

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on the merits. Accordingly, claims 55 and 56 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Accordingly, claims 1, 18-20, 22, 23, 28, 29, 32, 48-50, 53 and 54 are pending in this application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 18-20, 22, 23, 28, 29, 32, 48-50, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turner (Patent Number 6,241,493).

Regarding claims 1, 18-20 and 32 as shown in Figs. 1, 8 and 9, Turner discloses a fluid machine comprising: a housing (12) having a wall defining a generally spherical interior, the housing having at least one port opening (24, 26) in communication with the interior of the housing; a first shaft (32) mounted for rotation relative to the housing about a primary axis (33), at least one primary vane (50A, 50B) disposed within the interior of the housing that rotates about the primary axis of the first shaft; at least one secondary vane (98A, 98B) disposed within the interior of the housing and mounted to the primary vane on a first pivotal axis, the secondary vane pivotally oscillating between alternating relatively open and closed positions with respect to the primary vane and defining at least a chamber within the housing interior having a volume which varies as the primary vane is rotated about the primary axis; the adjustment being achieved by modifying the density of the materials of manufacture of the secondary vane (98A,

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98B); the adjustment is achieved by modifying the amount of void space or total material in the construction of the secondary vane (98A, 97B). However, Turner fails to disclose the primary vane (98A, 98B; 50A, 50B) being adjusted in weight or density to be made heavy relative to the weight or density of the secondary vane.

It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the heavy primary vane by adjusting weight or density of the primary vane relative to the weight or density of the secondary vane, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 289 (CCPA 1954). Note that in claims 1 and 32, the limitations “to provide additional stored momentum energy, which additionally energy is advantageous in the efficient operation and smooth operation of the fluid machine” is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Regarding claims 22, 23, 28, 29, 49, 50, 53 and 54, Turner further discloses the secondary vane (98A, 98B) is pivotally coupled to a carrier ring (116), so that the secondary vane is pivotal about a second pivotal axis perpendicular to the axis of rotation (33) of the carrier ring causing the secondary vane to reciprocate between relatively open and closed positions as the secondary vane is rotated about the primary axis by the first shaft; the axis of rotation of the

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carrier ring being oriented at an oblique angle in relation to the primary axis of the first shaft (32); a second shaft (40) that extends into the interior of the housing opposite the rotary shaft, the second shaft having a spherical portion about which the primary vane (50A, 50B) rotates and wherein the carrier ring is rotatably carried on the spherical portion of the second shaft; seals being installed on both primary and secondary vanes (50A, 50B, 98A, 98B) to contact the housing during operation and wherein seals are installed on both primary and secondary vanes to contact the spherical portion of the second shaft during operation; the second shaft (40) being adjustably mounted to the housing so that the second shaft (40) can be oriented in various fixed positions, and further comprising; an adjustable vane guide bearing member disposed within the housing, wherein the adjustable vane guide bearing member oscillates the secondary vane between relatively open and closed positions relative to the primary vane in response to rotation of the primary vane (50A, 50B), varying the point during rotation of the first shaft and the primary vane at which the secondary vane reaches the relatively open and closed positions relative to the housing and the port opening so that communication of the port opening with the chamber is adjusted and therefore the fluid flow volume and/or direction is adjusted (see claim 41).

Response to Arguments

4. Applicant's arguments with respect to claims 1, 18-20, 22, 23, 28, 29, 32, 48-50, 53 and 54 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

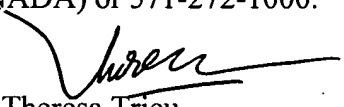
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TT
January 12, 2007



Theresa Trieu
Primary Examiner
Art Unit 3748